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10/600,178	06/20/2003	J. Kirk Haselden	MSFT-1741 (301923.01)	9748

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)	VU, TUAN A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

		Application No.	Applicant(s)
Office Action Summary		10/600,178	HASELDEN ET AL.
		Examiner	Art Unit	
		Tuan A. Vu	2193	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 November 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 15-22* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 15-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Applicant's response filed 11/30/07.

As indicated in Applicant's response, claims 1-2, 10, 15, 21 have been amended, and

claims 11-14 canceled. Claims 1-10, 15-22 are pending in the office action.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a " useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

3.   Claims 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

Claim 15 recites a computer-implemented system comprising data representative of

components dependencies and a merge module to generate a deployable bundle. There is

absence in the recited system of any hardware support/embodiment to carry out the functionality

construed as this 'merge module'. From the specifications, this module amounts to a software

entity (e.g. Fig. 4) which implies its being executable on any computer. However, the 'system'

is not recited as **including** a computer system or processor hardware, in order for one to know

whether any computer executing the merge module as disclosed is **really part of** the system;

thus, the system claim is still devoid of any hardware support or tangible apparatus to carry out

or realize the functionality of any software entity being claimed, as set forth in the Guidelines as

follows.

> The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.
> <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>

That is, because there is absence of explicit inclusion in the system claim of actual

hardware support or tangible embodiment thereof, the claim is perceived as unable to realize the

software functionality; i.e. to yield a tangible result, or being unable to yield a practical real

world result. The claim, for mere listing of "Functional Descriptive Material" (see Annex IV of

the Guidelines101.pdf, pg. 52-54) is therefore rejected as non-statutory by virtue of the

Guidelines.

Claims 16-18 are rejected for not remedying to the deficiency of claim 15. Claim 19 only

recites means for communicating, which can be construed as interfacing means between software

modules interaction, thus still lacks hardware to support the merging functionality of claim 15.

Hence claims 19 and 20 are also rejected for depending on a rejected subject matter of the base

claim.

Claim 21 is also a system claim but barely recites means for determining and means for

merging, all of which have been identified by virtue of prosecuting the statutory weight of claim

15 as mere software-based entities. The means therefore amounts to lack of hardware support in

order to carry such software functionality; hence along with claims 22 is also rejected as non-

statutory as set forth against claim 15.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1-10, 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claims 1 and 10 recite 'providing, by the components their dependencies to a cooperative interface'. There is no single portion in the Disclosure that clearly teach that an **active role by** the components enabling the components to provide their own dependencies to a cooperative interface. The Disclosure discloses a package task for exposing dependencies (para 0042, pg 12), merge modules to merge components scanned from merge tables (para 0032, pg. 9; para 0040-0041, pg. 11); and components implementing an interface that enumerates files (para 0031, pg. 9). The components , which are perceived as generic computer components (see para 0021, pg. 5) are not taught as actively **providing their** dependencies **to** a cooperating interface, absent any detail description about how the components are is implemented with this 'providing' functionality. Thus, this *providing by the components* limitation will not be given any serious patentable weight. For prosecuting the claims, this 'providing by' limitation will be treated as computer component type of implementation whereby a cooperating interface is being provided with knowledge about 'the components', e.g. about their dependencies.

Claims 2-9 are also rejected for not providing teaching as to how the 'components' are

capable of providing information to the 'cooperating interface'.

Claim 21 also recites 'components providing the dependencies to the means for

determining'; and there no sufficient disclosure to support how components have functionality to

provide their own dependencies; and as set forth above, will be rejected as lack proper

description. Claim 22 is also rejected for not providing remedy to said lack of disclosure

support.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this
> or a foreign country, before the invention thereof by the applicant for a patent.

7.   Claims 1-10, 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Crystal

Decisions, 'Report Designer Component 9', Creating a RDC Deployment Package, 5/14/2000,

pp. 1-17

<http://resources.businessobjects.com/support/communitycs/TechnicalPapers/rdc9_deployment.

pdf> (hereinafter Rdc_9)

As per claim 1, Rdc_9 discloses a method for deployment of components, comprising:

defining dependencies by components of pluggable component-based software (e.g.

Runtime files, pg. 2; Crystall DLLs, Other Dlls , pg. 2-3; *Dependency files* – pg. 6-7), wherein at

least one component of a deployable bundle is provided by a third party (e.g. *Visual Studio*

Installer ... Microsoft DLLs, pg. 2, top; *Crystal Decisions ... support site*, pg. 3);

wherein providing, by the components expose their dependencies (e.g. merge modules, Runtime help file – pg. 3;) to a cooperating interface (e.g. Visual Studio Installer, pg. 4);

generating, by the cooperating interface, a list of defined dependencies (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; Merge Modules, *Rdcruntime.msm ... contains the ... files, expose ... a License Key–* pg. 6, top half; *Runtime.chm ... which files need to be added to your VB ... package* - pg. 11);

identifying, by the cooperating interface (Visual Studio Installer, pg. 4-5), files associated with the list of defined dependencies (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; Merge Modules, *Rdcruntime.msm ... contains the ... files, expose ... a License Key–* pg. 6, top half); and

processing, by the cooperating interface, the dependency list of defined dependencies and identified files to generate the deployable bundle (e.g. *add any additional files, make additional changes* – pg. 5; step 6 pg. 7; *Set up Wizard*, steps 6-7, pg. 9; pg. 13) and deploying the deployable bundle (*distribute it to your client* – pg. 5 bottom).

As per claim 2, Rdc_9 communicating deploying the deployable bundle to a cooperating environment (e.g. pg. 4; pg.7, pg. 9, pg. 10 – Note: Microsoft Visual installer reads on cooperating insterface for receiving bundle data of new project to install).

As per claim 3, Rdc_9 discloses merging (Method 1: merge modules, pg. 1-6) the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claim 1; *required ... modules*, step 3, pg. 5).

As per claim 4, Rdc_9 discloses scanning the components to identify default elements (e.g. step 3, pg.5; *required ... modules*, step 3, pg. 5; *Craxddrt9.dep*, step 1, 6, pg. 6-7) and non-

default elements (e.g. Mdac.msm ... not always required – pg. 5; *inform the user that they need to upgrade* – NOTE, pg. 5; Add Extra Files pg. 13).

As per claim 5, Rdc_9 discloses providing an installer component (step 7, pg. 9; step 3, pg.10; step 2, pg. 12; *.msi file* - pg. 15-16; *Output file Name, Output Folder* , pg. 16) for inclusion in the deployable bundle.

As per claims 6-7, Rdc_9 discloses validating the deployable (Mdac ... will inform the user that they need to upgrade – pg. 11; *Report Creation API ... prompted to insert the required lisence* – pg. 12; *This file cannot be registered* – pg. 15, top); providing configuration files (e.g. *Readme.txt* pg. 3) for inclusion in the deployable bundle.

As per claim 8, Rdc_9 discloses merging the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claim 1- Note: RDC Deployment package using VS installer and Method 1, Method 2, Method 3- pg. 4--pg. 11 reads on merging list, and files and default components into a final installer package – see claims 3-5).

As per claim 9, Rdc_9 discloses providing a merge module (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; Merge Modules, *Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half) for performing the merge of the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claims 3-5).

As per claim 10, Rdc_9 discloses a computer readable storage medium having computer readable instructions for:

defining dependencies by components of pluggable component-based software, wherein at least one component of a deployable bundle is provided by a third party;

wherein providing, by the components expose their dependencies to a cooperating interface;

generating, by the cooperating interface, a list of defined dependencies;

identifying, by the cooperating interface, files associated with the list of defined dependencies;

processing, by the cooperating interface, the dependency list of defined dependencies and identified files to generate the deployable bundle; and

deploying the deployable bundle;

all of which having been addressed correspondingly in claim 1.

As per claim 15, Rdc_9 discloses a computer-implemented system to deploy a package having dependencies comprising:

dependency data representative of the dependencies of components of the package (e.g. *Runtime files, pg. 2*; Crystall DLLs, Other Dlls , pg. 2-3; *Dependency files* – pg. 6-7),

the package comprising pluggable component-based software, wherein at least one component of a deployable bundle is provided by a third party (refer to claim 1); and

a merge module executing on a computer, the merge module operating to merge the dependency data (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; *Merge Modules, Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half; *Runtime.chm ... which files need to be added to your VB ... package* - pg. 11) with the components of the package to generate the deployable bundle (e.g. *add any additional files, make additional changes* – pg. 5; step 6 pg. 7; *Set up Wizard*, steps 6-7, pg. 9; pg. 13; *distribute it to your client* – pg. 5 bottom – refer to claims 3-5).

As per claim 16, Rdc_9 discloses comprising an installer, the installer (refer to claim 5; e.g. *.msi file* - pg. 15-16; *Output file Name, Output Folder* , pg. 16) being merged by the merge module to generate the deployable bundle.

As per claims 17-18, Rdc_9 discloses further comprising configuration information (refer to claim), the configuration information being merged by the merge module to generate the deployable bundle;

default package components (refer to claim 4), the default package components being merged by the merge module to generate the deployable bundle.

As per claim 19, Rdc_9 discloses communication means for use in communicating the deployable bundle to a cooperating computing environment (pg. 15-16 – Note: GUI interface to communicate with user – see pg. 3, 10, 14 - as means for adding and finalizing the installer reads on means use in communicating deployable to a cooperating environment operable via a computer user).

As per claim 20, refer to claim 6.

As per claim 21, Rdc_9 discloses a system for use in the deployment of components having dependencies comprising a means, each for:

determining the dependencies of components of pluggable component- based software (see GUI interface to communicate with user – see pg. 3, 10, 14), wherein at least one component of a deployable bundle is provided by a third party (e.g. *Visual Studio Installer ... Microsoft DLLs*, pg. 2, top; *Crystal Decisions ... support site*, pg. 3), the components providing the dependencies (e.g. merge modules, Runtime help file – pg. 3;Visual Studio Installer, pg. 4) to the means for determining;

merging the determined dependencies of the components with the components of the

pluggable component-based software (steps 1-3, pg. 5; step 3-4, pg. 5; *Merge Modules,*

Rdcruntime.msm ... contains the ... files, expose ... a License Key– pg. 6, top half; *Runtime.chm*

... which files need to be added to your VB ... package - pg. 11) to generate the deployable

bundle (refer to claim 9).

.**As per claim 22,** refer to claim 9.

Response to Arguments

8.   Applicant's arguments filed 11/30/07 have been fully considered but they are moot in

light of the new grounds of rejection which have been necessitated by the Amendments.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tuan A Vu whose telephone number is (571) 272-3735. The

examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Meng-Ai An can be reached on (571)272-3756.

The fax phone number for the organization where this application or proceeding is

assigned is (571) 273-3735 (for non-official correspondence - please consult Examiner before

using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-

272-3609.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan A Vu
Patent Examiner,
Art Unit 2193
January 27, 2008